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| EXAMINER | |
|---|---|
| PERRY, LINDA C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3693 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/762,466 | LORTSCHER, FRANK DUANE | |
| | Examiner | Art Unit | |
| | LINDA C. PERRY | 3693 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 January 2004 and 28 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *44-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-43 and 55-64* are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1/23/2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/8/04, 3/18/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

This application is responsive to application no. 10762466 filed 1/23/2004 and amended 3/14/2006. Claims 1-64 were considered. Claims 44-54 were elected after an election/restriction requirement, with traverse.

### *Priority*

Applicants' claim to benefit of provisional application no. 60441756 filed 1/23/2003 is acknowledged.

### *Information Disclosure Statement*

The information disclosure statements filed 10/18/2004 and 3/18/2005 are being considered by the examiner.

### *Specification*

The disclosure is objected to because of the following informalities:

Paragraph ¶ [0012] 'dvantage' should read advantage'.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 44 is rejected under 35 U.S.C. 102(b) as anticipated by Lupien et al. (5101353 hereinafter Lupien) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lupien et al. (5101353 hereinafter Lupien), and further in view of Gatto (6510419).

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (5101353 hereinafter Lupien), and further in view of Gatto (6510419).

Regarding claim 44, Lupien teaches *a method for generating a recommendation* (see at least **Abstract, column 3 lines 28-37**), *comprising steps of: receiving transaction data relating to a plurality of transactions* (see at least **column 4 lines 32-41**), *the transaction data including an object name, object price, a size of the transaction* (see at least **Figures 5 and 6, column 8 line 33-column 9 line 33**), *receiving data relating to a proposed transaction* (see at least **column 3 lines 17-36, column 3 line 68 – column 4 line6**), *the proposed transaction data including proposed object name, object price, transaction size* (see at least **Figure 2, column 7 lines 47-column 8 line 18**), *determining which transactions of said transaction data are relevant to said proposed transaction* (see at least **column 4 lines 32-41, column 5 line 7-17**); *and generating a recommendation relating to said proposed transaction based on said transaction data of the transactions determined to be relevant* (see at least **column 3 line 68 – column 4 line 41, column 4 lines 58-65**).

Lupien suggests receiving data concerning the transaction entities (see at least **column 12 line 66-column 7 line 23, column 14 line 66-column 15 line 2 claim 1, 7**) but does not explicitly name different entities . Lupien does make it clear that the user's transactions pending (i.e. proposed) are observable *at least one transaction entity identifying a party to the proposed transaction* (see at least **column 7 lines 15-26**), and the claim could be interpreted to mean that the transaction data relating to a plurality of transactions could also be the user's own, in which case the entire claims is anticipated under 35 U.S.C. 103(a) by Lupien.

However, Examiner has assumed that Applicants may have meant the 'plurality of transactions' to be transactions by another.

Gatto teaches [receiving transaction data relating to a plurality of transactions the transaction data including] *and at least one transaction entity identifying a party to the transaction* (see at least (display) actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47**)

Claims 45 – 50 and 53-54 are rejected under 35 U.S.C. 103(a) as obvious over Lupien et al. (5101353 hereinafter Lupien), and further in view of Gatto (6510419).

Regarding claim 45, Lupien does not teach the weighting specified.

Gatto teaches *said recommendation is generated by weighting each transaction of said transactions determined to be relevant based on at least a level of expertise of the trading entity that decided to make the transaction, and aggregating the weighted data* (see at least **column 2 lines 48-55,** actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47, column 6 lines 53-61**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the weighting of transactions as taught by Gatto. The motivation would be to use known information about profitability of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 46, Lupien teaches listing the market types of trades (buy or sell, see at least **Figure 6, column 8 lines 52-68**), but does not specify weighting, whether or not using types.

Gatto teaches *said recommendation is generated by weighting each transaction data of said transactions determined to be relevant based on a level of expertise of the trading entity that decided to make the transaction for transactions being of a same type as the a type of the proposed transaction, and aggregating the weighted data* (see at least weighting factor based on predetermined criteria **column 2 lines 48-55,** actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47,** analysts' performance tracked and analyzed using raw data and pre-calculated values (which) may be maintained in a database **column 54 lines 39-55,** fields in pre-calculated data may include event identifier **column 5 lines 4-21,** user may consider profitability of recommendations to purchase, sell, or hold **column 6 lines 43-61**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the weighting of transactions as taught by Gatto. The motivation would be to use known information about profitability of types of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely

would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 47, Lupien does not teach the described weighting.

Gatto teaches *wherein said recommendation is generated by weighting each transaction data of said transactions determined to be relevant based on a level of expertise of the entity that decided to make the transaction for transactions of a same size as the proposed size of the proposed transaction, and aggregating the weighted data* (see at least weighting factor based on predetermined criteria **column 2 lines 48-55,** actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47,** test profitability of rules for one or more analysts' determining how much of a security to buy or sell **column 6 lines 43-67**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the weighting of transactions as taught by Gatto. The motivation would be to use known information about profitability of sizes of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 48, Lupien does not teach the described weighting.

Gatto teaches *said recommendation is generated by weighting each transaction data of said transactions determined to be relevant based on a level of expertise of the trading entity that decided to make the transaction for transactions in a same industry as the industry of the proposed transaction, and aggregating the weighted data* (see at least weighting factor based on predetermined criteria **column 2 lines 48-55,** actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47,** weighting factor may be based on a variety of factors **column 4 lines 4-12** compare performance for a particular industry **column 3 lines 24-26**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the weighting of transactions as taught by Gatto. The motivation would be to use known information about profitability of sizes of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 49, Lupien does not teach the described weighting.

Gatto teaches *wherein said recommendation is generated by weighting each*

*transaction data of said transactions determined to be relevant based on a level of expertise of the trading entity that decided to make the transaction, on each of transaction action type, on industry type, and on a recency of the transaction relative to said proposed transaction, and aggregating the weighted data (*see at least factor based on predetermined criteria **column 2 lines 48-55,** actual (contributor(s)) earnings corresponding to estimates **column 3 lines 40-47,** weighting factor may be based on a variety of factors including recency **column 4 lines 4-12,** analysts' performance tracked and analyzed using raw data and pre-calculated values (which) may be maintained in a database **column 54 lines 39-55,** fields in pre-calculated data may include event identifier **column 5 lines 4-21,** user may consider profitability of recommendations to purchase, sell, or hold **column 6 lines 43-61,** compare performance for a particular industry **column 3 lines 24-26**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the weighting of transactions as taught by Gatto. The motivation would be to use known information about profitability of sizes of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 50, Lupien teaches *said transactions comprise securities*

*transactions and said step of receiving data relating to a proposed transaction includes a step of making a market order, said proposed transaction being based on said market order* (see at least **Figures 2 -6, column 9 lines 23-28**).

Regarding claim 53, Lupien does not teach the described rules regarding execution of an order.

Gatto teaches *a step of executing said market order if said recommendation relating to said proposed transaction meets a predetermined criteria* (see at least portfolio-creation rules to determine how much of a security to buy or sell, **column 6 lines 53-67, column 4 lines 4-38**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the model for execution of an order based on recommendation criteria as taught by Gatto. The motivation would be to use known information about profitability of sizes of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding claim 54, Lupien teaches making a market order per claim 50 and

describes executing orders, **Figure 4,** but does not describe recommendations generating a numeric indicator which governs execution of the order.

Gatto teaches *recommendation generated comprises a numeric indicator* (see at least **column 4 lines 20-24**) *and said market order is executed if said recommendation exceeds a predetermined value* (see at least portfolio-creation rules to determine how much of a security to buy or sell, **column 6 lines 61-67**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by Lupien to adapt the model for execution of an order based on a numeric indicator as taught by Gatto. The motivation would be to use known information about profitability of sizes of transactions named by particular entities to quantify advisability of a proposed transaction. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 51 is rejected under 35 U.S.C. 103(a) as obvious over Lupien et al. (5101353 hereinafter Lupien), and further in view of Gatto (6510419), and further in view of Reese (6370516).

Regarding claim 51, neither Lupien nor Gatto teaches real estate transactions as being received or real estate contracts as being proposed.

Reese teaches, in the context of a system that analyzes advisors' criteria for a security, *transactions* [which] *comprise real estate transactions and said proposed transaction* [which] *includes a proposed real estate contract* (securities include real estate **column 31 lines 26- 45**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of generating a recommendation as taught by the combination of Lupien and Gatto to adapt a wider range of assets to be traded as taught by Reese. The motivation would be to apply analysis of recommendations to a wide range of assets. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 52 is rejected under 35 U.S.C. 103(a) as obvious over Lupien et al. (5101353 hereinafter Lupien), and further in view of Gatto (6510419), and further in view of Wilmes et al. (US 2002/0116302 hereinafter Wilmes).

Regarding claim 52, neither Lupien nor Gatto teaches betting transactions as being received or bets as being proposed.

Wilmes teaches *said transactions comprise gambling transactions and said step of receiving data relating to a proposed transaction includes a step of making a proposed bet, said proposed transaction being based on said proposed bet*

(transactions subject to usual business requirements, such as tax settlement, may be wagers received, see at least **Abstract, ¶ [0092]**).

***Response to Response to Restriction/Election Requirement***

Applicants assert that restriction between Groups III and IV is improper, but do not argue persuasively. Groups III and IV are obviously not overlapping in scope, or obvious variants, as Group IV is a method for generating a recommendation, based on relevant transaction data. Examiner notes that this may include any recommendation and any transaction data, and thus need not include either the investment recommendation or the basis in competency ratings or confidence ratings of Group III. For the same reasons, Groups III and IV are not obvious variants, as their subjects can be from entirely different domains. For example, claim 44 of Group IV could describe a recommendation concerning a scope of a transaction for the purchase of landscaping services based on relevant (like) transactions, not overlapping nor an obvious variant of an investment recommendation based on relevant (investment) transaction data, competency ratings, and confidence ratings. Group III obviously has separate utility and there would be a serious search and examination burden if restriction were not required.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDA C. PERRY whose telephone number is (571)270-1466. The examiner can normally be reached on 8-5 alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571 272 6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Linda C Perry/
Examiner, Art Unit 3693

03 September 2008.

/Stefanos Karmis/
Primary Examiner, Art Unit 3693